

REMARKS

Applicants have carefully considered the June 3, 2004 Office Action, and the amendments above together with the comments that follow are presented in a bona fide effort to address all issues raised in that Action and thereby place this case in condition for allowance. Claims 1-17 were pending in this application. Claims 12-13 were withdrawn from consideration pursuant to the previous restriction requirement. Claims 2-6, 9-13 and 15-17 have been canceled; and pending claims 1, 7, 8 and 14 have been amended.

Adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, the depicted embodiments and related discussion thereof in the written description of the specification. Applicants submit that the present Amendment does not generate any new matter issue. Entry of the present Amendment is respectfully solicited. It is believed that this response places this case in condition for allowance. Hence, prompt favorable reconsideration of this case is solicited.

The Examiner objected to Figures 1 through 4 and asserted that these figures should be designated with a legend such as "Prior Art". Applicants have amended Figures 1-4 to include the "Prior Art" legend. Accordingly, the Examiner is requested to withdraw the drawing objection.

Claims 1-17 were rejected under the second paragraph of 35 U.S.C. § 112. Claims 2-6, 9-13 and 15-17 have been canceled and, therefore, the rejection is moot with respect to these claims. Moreover, claim 1 has been amended to clarify that the claimed disc-case does contain a disc-shaped recording medium, while claim 14 has been amended to clarify that the claimed case is capable of enclosing a disc-shaped recording medium, but does not positively recite a disc-shaped recording medium. Further, claims 1 and 14 have been amended to clarify that the elastic

deformation part is capable of being deformed in a direction outside of the disc-case or case. Applicants submit that one having ordinary skill in the art would not have difficulty understanding the scope of claims 1 and 14, particularly when reasonably interpreted in light of the supporting specification. Claims 7 and 8 have been amended to change “the” to “a” and thereby obviate any questions about antecedent basis support for the tip of the elastic deformation part (claim 7) and the recited radial direction (claim 8). Therefore, it is respectfully submitted that the imposed rejection of pending claims 1, 7, 8 and 14 under 35 U.S.C. § 112, second paragraph is not legally viable and hence, Applicants solicit withdrawal thereof.

Claims 1-9, 11 and 14-17 were rejected under 35 U.S.C. § 102(b) as being anticipated over Kaufman et al. (U.S. Pat. No. 5,573,120, hereinafter “Kaufman”). Applicants respectfully traverse.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claim, such that the identically claimed subject matter is placed into the possession of one having ordinary skill in the art. There are significant differences between the claimed subject matter and the compact disc storage container disclosed by Kaufman that would preclude the factual determination that Kaufman identically describes the claimed disc case of independent claim 1 or the claimed case of independent claim 14 within the meaning of 35 U.S.C. § 102.

Claim 1, as amended, discloses a disc case comprising an elastic deformation part of a cantilever structure for holding the disc-shaped recording medium and a fixed flange part for holding the disc-shaped recording medium in cooperation with the elastic deformation part. In contrast, Kaufman fails to disclose or suggest any fixed flange part for holding the disc, much less a fixed flange part in combination with an elastic deformation part for holding the disc. Rather,

Kaufman discloses a compact disc storage container to hold/keep a disc. As described at column 6, lines 55-59, Kaufman discloses an upraised receiver 80 adapted to receive the central vertical hole in a compact disc 72 so as to releasably hold the disc on the tongue 74 and in the space and also to keep it on the tongue 74 when it is raised up therewith. The compact disc storage container has a structure to hold the central hole with the upraised receiver 80. Therefore, Kaufman is silent as to a fixed flange part for holding the disc-shaped recording medium in cooperation with an elastic deformation part

Claim 14, as amended, discloses a case comprising an elastic deformation part of a cantilever structure for holding a disc-shaped recording medium and a fixed flange part for holding the disc shaped recording medium in cooperation with the elastic deformation part. In contrast, Kaufman fails to disclose or suggest any fixed flange part for holding a disc, much less a fixed flange part in combination with an elastic deformation part for holding a disc.

As described in specification at page 7, lines 18-20, the claimed disc case (claim 1) and case (claim 14) are designed to be mounted in a recording and reproducing apparatus. The simplified structure of the claimed disc case and case is an improvement over the existing art and facilitates removal of a disc. Moreover, in contrast to Kaufman, the presently claimed case or disc case has a structure opened to the outside, without an element fitted into a central hole of a disc which may be accommodated in the case or the disc case, as shown in Figs. 5 and 6.

Accordingly, for the reasons outlined above, Kaufman fails to identically describe the claimed subject matter as recited in independent claims 1 and 14. Accordingly, the rejection of independent claims 1 and 14, as well as dependent claims 7-8, under 35 U.S.C. § 102 is not legally viable and should be withdrawn.

Claim 10 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Kaufman et al. (U.S. Pat. No. 5,573,120, hereinafter "Kaufman"). Claim 10 has been canceled and, therefore, the rejection is moot with respect to this claim.

It is believed that all pending claims are now in condition for allowance. Applicants therefore respectfully request an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, the Examiner is invited to call Applicants' representative at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT WILL & EMERY LLP



Brian K. Seidleck
Registration No. 51,321

600 13th Street, N.W.
Washington, DC 20005-3096
202.756.8000 BKS:apr
Facsimile: 202.756.8087
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